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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,344	07/06/2007	**Stephan Brandstadter**	PC3-301	6589

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EXAMINER	
NWAONICHA, CHUKWUMA O	
ART UNIT	PAPER NUMBER
1621	
MAIL DATE	DELIVERY MODE
04/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/587,344	BRANDSTADTER ET AL.	
	Examiner	Art Unit	
	CHUKWUMA O. NWAONICHA	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,6,7,9,10 and 12-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,6,7,9,10 and 12-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Current Status

1. Claims 1, 6, 7, 9, 10, and 12-17 are pending in the application.

2. This action is responsive to Applicants' amendment of 28 December 2007.

3. Receipt and entry of Applicants' amendment is acknowledged.

4. The rejection of claims 1, 6, 9, 10, and 12-15 under 35 U.S.C. 102(b) as being anticipated by Caporiccio et al. and Vasil'eve et al., for the reasons set forth in the previous Office Action of 10/23/2007 is withdrawn following Applicants amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specifically ", hydrogen, carbon and halogens" does not reasonably provide enablement for "any atom of the periodic table of elements" as claimed.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The standard for determining whether the specification meets the enablement requirement is whether experimentation needed to practice the invention is undue or

unreasonable. Accordingly, even though the forgoing statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. See M.P.E.P. § 2164.

In the instant case, the claims cover “any atom of the periodic table of elements”. Based on the above standards, the disclosure must contained sufficient information to enable one skilled in the pertinent art to practice this invention without undue experimentation. See M.P.E.P. 2164.01. Given the lack of disclosure of “any atom of the periodic table of elements”, the instant invention cannot be practiced commensurate in scope with the claims.

The Examiner understands that there is no requirement that the specification disclose every possible embodiment if there is sufficient guidance given by knowledge in the art (See M.P.E.P. § 2164.05(a)). However, the instant case goes beyond what is known in the art, because the specification does not offer any guidance on how one of ordinary skill would go about practicing the invention from the claim to “any atom of the periodic table of elements”

Here, the requirement for enablement is not met since the claims go far beyond the enabling disclosure. Based on the forgoing, **claim 10** is *prima facie* non-enabled for their full scope.

With regard to rejection under 35 U. S. C. 112, first paragraph, the following factors have been carefully considered (***In re* Wands**, 8 USPQ2d 1400; CAFC, 1988):

1. the nature of the invention,

2. the state of the prior art,
3. the predictability or lack thereof in the art,
4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

(1) **Nature of the invention.** As indicated above, the invention is drawn to "hydrogen, carbon and halogens, and any atom of the periodic table of elements".

(2) **Breadth of the Claims.** The claims are extremely broad. In particular, **claim 10** that read on specifically "any atom of the periodic table of elements".

(4) **Unpredictability of the Art.** The instant case is drawn to "any atom of the periodic table of elements". Any "atom of the periodic table of elements" as claimed is speculative. Applicants' claim of "any atom of the periodic table of elements" is doubtful and requires objective proof. In such a speculative field, more enablement by way of specific examples is necessary in order to establish the utility of a genus. In re Fisher, 166 U.S.P.Q. 18.

(5) **Amount of Guidance Provided.** Applicants have provided guidance to the nature of hydrogen, carbon and halogens in compounds of the composition. However, when considering that the claims read on "any atom of the periodic table of elements", it becomes critical to know all atoms of the periodic table of elements that applicants are claiming. This is critical to the practice of the invention and therefore should adequately be disclosed.

(7) **Ordinary Skill in the Art.** The ordinary skill artisan would not be able to practice the claimed invention with the current disclosure. It is not clear how to employ the entire atoms of the periodic table of elements applicant are claiming.

Thus, it can safely be concluded that the instant disclosure fails to provide an enabling disclosure for "any atom of the periodic table of elements" as claimed.

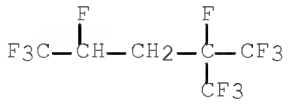
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Becker {DE 43 05 239}.

Becker discloses applicants' claimed composition comprising the compound shown below. Also, see compound D on page 3.



Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6, 7, 9, 10, and 12-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6-10 and 12-14 of copending Application No. 11/981,857, claims 1, 2, 4 and 7-14 of copending Application No. 11/192,832 in view of Brandstadter et al., claims 1, 3, 4 and 6 of copending Application No. 11/559,330 in view of Brandstadter et al., claim 15 of copending Application No. 11/784,447 in view of Brandstadter et al. and claims 15 of copending Application No. 11/982,247 in view of Brandstadter et al. This is a provisional obviousness-type double patenting rejection.

Applicants claim a composition comprising the general formula 1,

$(R_f(R_T)_nQ$ and $(R_{cl}(R_T)_nH$ formula 1

wherein all the variables are as defined in the claims while the copending Applications No. 11/981,857 and 11/192,832 teach a composition comprising the general formula 2; wherein the variables are defined in the claims. See claims 1, 2, 6-10 and 12-14 of copending Applications No. 11/981,857, claims 1, 2, 4 and 7-14 of copending Application No. 11/192,832, claims 1, 3, 4 and 6 of copending Application No. 11/559,330, claim 15 of copending Application No. 11/784,447 and claims 15 of copending Application No. 11/982,247.

$(R_f(R_T)_nQ$ and $(R_{cl}(R_T)_nH$ formula 2

Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlaps substantially with the scope of claims 1, 2, 6-10 and 12-14 of the copending Application No. 11/981,857, claims 1, 2, 4 and 7-14 of copending Application No. 11/192,832, claims 1, 3, 4 and 6 of copending Application No. 11/559,330, claim 15 of copending Application No. 11/784,447 and claims 15 of copending Application No. 11/982,247. The genus of the copending Applications encompasses the species in the presently claim invention; wherein the variables R_f, $\mathbf{R_{cl}}$ and R_T in the copending Applications are defined as $-CF_2(CF_3)CH-$, C_6F_{13}, at least one C-2 group and CF_3. The difference is not a patentable distinction because the copending Application Nos. 11/981,857, 11/192,832, 11/559,330, 11/784,447 and 11/982,247 teach the elements of the claimed invention with sufficient guidance, particularity, and with a reasonable expectation of success, that the invention would be *prima facie* obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/
Examiner, Art Unit 1621

/Jafar Parsa/
Primary Examiner, Art Unit 1621
March 29, 2008